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IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1965.

No. 288

WELSH CO.,
Petitioner,

vs.

VICTOR A. CHERNIVSKY, d/b/a COMFY BABE COMPANY,
Respondent.

PETITION FOR A WRIT OF CERTIORARI

To the United States Court of Appeals for the Seventh Circuit.

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INDEX.

	Page
Opinions below	2
Dates of Judgments	2
Jurisdiction	2
Questions presented	2
Statute involved	2
Statement of the case	3
The patented article	3
Procedure in the Patent Office	5
The omitted feature	5
Reasons for granting the writ	6
Appendix A—Opinion of Court of Appeals	12
Appendix B—Court's order denying rehearing	26
Appendix C—Opinion in the Ekco Products Company case, No. 14859 in the Court of Appeals for the seventh circuit	27

Cases Cited.

Black Diamond Coal Co. v. Excelsior Coal Co., 156 U. S. 611, 39 L. Ed. 553	6
General Electric Co. v. Wabash Corp., 304 U. S. 364	8
Hubbell v. United States, 179 U. S. 77	6
Jogger Mfg. Corp. v. Rocquemor (C. A. 7), 118 F. 2d 867, 870	6
Luberman v. Rowell, 170 F. 590, 592 (3 Cir. 1909)	9

Schmitt v. Norcor Mfg. Co., 152 Fed. 519 (7 Cir. 1945) 9
Standard Mirror Co. v. H. W. Brown, Inc., 113 F. 2d 379 (7 Cir. 1940) 9
The Ekco Products Company, Inc. v. Chicago Metallic Mfg. Co., decided June 17, 1965?..... 10
Vance v. Campbell, Black (66 U. S.) 427, 430..... 6
Weatherheard v. Coupe, 147 U. S. 322 6

Statutes Cited.

28 U. S. C., Sections 1254 and 2101 (c) 2
35 U. S. C., Section 112 ..... 2, 3
35 U. S. C., Section 271 2

Textbook Cited.

Walker on Patents, Deller Ed., Vol. 3 ..... 6, 7

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VICTOR A. CHERNIVSKY, d/b/a COMFY BABE COMPANY,
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PETITION FOR A WRIT OF CERTIORARI

To the United States Court of Appeals for the Seventh Circuit.

Welsh Co. prays that a Writ of Certiorari issue to review the Judgment and final decision of the United States Court of Appeals for the Seventh Circuit in a case entitled "**Welsh Co.**, Plaintiff-Appellee, **v. Victor A. Chernivsky**, d/b/a **Comfy Babe Company**, Defendant-Appellant" because the Court of Appeals, in reversing a decision of the District Court, has decided a Federal question in a way in conflict with applicable statute and decisions of this Court, and such that the consequences will be gravely injurious to industry and the general public if allowed to remain as law in the Seventh Circuit.

OPINIONS BELOW.

The opinion of the Court of Appeals is reported in 342 F. 2d 586; 144 USPQ 288, and appears as Appendix A hereto. That Court's Order denying rehearing appears as Appendix B. The decision on the merits and opinion of the District Court (not reported) appears on page 219 of the Certified Appendix to Defendant-Appellant's Brief to the Circuit Court of Appeals.

DATES OF JUDGMENTS.

The Judgment of the Court of Appeals was rendered January 21, 1965. Timely petition for rehearing was filed and was denied by order made and entered on March 30, 1965.

JURISDICTION.

Jurisdiction of this Court is invoked under 28 U. S. Code, Sections 1254 and 2101 (c).

QUESTION PRESENTED.

Whether the Court of Appeals in reversing the District Court, rightly adjudged infringement of a patent for a combination of old elements and a single novel element, by a device that omits from its structure the novel element and feature of the combination claimed by the patent.

STATUTE INVOLVED.

The patent statute is involved. Title 35, United States Code, Sections 271 and 112 state:

> "271 (a) Except as otherwise provided in this title, whosoever without authority makes, uses, or sells any patented invention within the United States during the term of the patent therefor, infringes the patent.

112. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

STATEMENT OF THE CASE.

This action was brought by Petitioner, Welsh Co. for a declaratory judgment of invalidity and noninfringement of Patent No. 2,848,040 for a Baby Chair. Respondent counterclaimed, alleging infringement of claims 1 and 3 of the patent.

The District Court adjudged "that as limited to the particular combination of old elements and the novel frictional locking feature, defendant's structure is invention over the prior art * * * and is valid" (R. 227).* The District Court further ruled that "Plaintiff's baby support does not embody the frictional locking feature so vital to Defendant's patent" and does not infringe (R. 229); that amendments and limiting constructions placed on the claims by Patentee when before the Patent Office now estop him from obtaining a construction of the claims to cover a combination wherein the frictional locking feature has been omitted (R. 228, 229).

Respondent appealed from the judgment of no infringement.

No appeal was made from the judgment of validity.

The Court of Appeals reversed the District Court's judgment of no infringement.

THE PATENTED ARTICLE.

The claimed invention involves only the frame part of an infant's chair which is well illustrated in Fig. 2 of the Chernivsky patent (P X 1). The frame is formed of

* The letter "R" refers to the Appendix to Brief for Defendants-Appellants filed in the Court of Appeals.

wire and comprises a U-shaped base 10, and a U-shaped backrest 12. Connection between the free end parts is provided for by sleeves on the extremities of the backrest, into which the ends of the base are inserted. To obtain a tight connection while permitting of convenient disassembly the extremities of the ends of the base are given a special formation, described in the patent specification, column 2, line 5:

> "At the front of each side is a bent portion 20 extending forwardly and outwardly and returning in an upwardly flared side 22 having an extremity 24 deflected outward and out of line with side portion 16."

and at column 2, line 20

> "The other end of each (sleeve) member is open for receiving the outwardly deflected end 24 of the base member so that in order to apply the back to the base, one extremity is first inserted in one of the sleeves and then the back must be tilted or sprung to cover the other deflected end 24 of the base so that when the deflected ends are set firmly into the connecting sleeves 14, the base and back will be firmly connected together against accidental displacement."

The Patent Office and both Courts found the features of the patented device to be old or obvious from disclosures of prior patents with the exception of the deflected end extremities of the base that produce the tight fit, or friction lock.

For a full understanding of the relatively simple invention involved herein it should be understood that the described connection, and the broad concept of springing one wire member before inserting its end into a companion sleeve member is broadly shown in the prior art cited by the Patent Examiner. See Watrous patent (P X 10), Fig. 12.

PROCEDURE IN THE PATENT OFFICE.

During the application stage of the patent in suit Respondent attempted to obtain claims without the limitation of the deflected end extremities. These claims were repeatedly and finally rejected on the prior art and were cancelled. Three new claims were substituted for the cancelled ones adding to the latter the limitation that the "extremities of the ends of the base are inclined slightly out of line with said hollow extremities of the backrest so the extremities of the base must be sprung to engage the hollow extremities." The Applicant emphasized that it was the inclined end extremities of the ends of the base that was sprung out of line with the sleeves (File Wrapper page 26); that the prior art does not disclose a construction which requires the ends of one part to be sprung into engagement with another part (File Wrapper p. 27), and finally the disclaimer:

> "The Applicant is not attempting to claim broadly any arm or other member which may be sprung into engagement with another," (file wrapper p. 27).

With the amendments and these explanations the substituted claims were allowed.

THE OMITTED FEATURE.

The Courts agree that petitioner's accused frame omits inclined end extremities 24, essential to the creation of the patentee's claimed tightly fitting connection (R. 220: Appendix A, pp. 14, 15). The District Court made the factual finding with respect to petitioner's device:

> "there is no locking feature on this device as embodied in that of defendant's whereby short stubs on the extremities of the upper sides of the base must also be sprung. * * * The advantage of the locking accomplished by the frictional engagement was dem-

onstrated several times during the trial when plaintiff's structure, lacking this feature, separated at the connection upon being lifted by the backrest" (R. 220, 221).

REASONS FOR GRANTING THE WRIT.

I.

In holding that a competitor may not avoid infringement of a claim for a combination of elements by omitting the novel element of that combination (Appendix, pp. 7 and 8), the Court of Appeals has decided a question of great importance to industry contrary to the decisions of this Court and of its own, and contrary to the interests of justice. Its decision contradicts a fundamental rule of patent law, that the omission of a single element or ingredient of a combination covered by a claim of a patent, averts any charge of infringement based on that claim.[1] Any departure from this well founded principle places serious limitations on the right to compete in the manufacture and sale of unpatented products.

A combination is an entirety. If one of its elements is omitted, the thing claimed disappears. Every part of the combination claimed is conclusively presumed to be material to the combination.[2]

The Court below reached the ultimate in contradicting the established law. Heretofore the omission of any element of a combination covered by a claim, whether a novel

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[1] *Black Diamond Coal Co. v. Excelsior Coal Co.*, 156 U. S. 611, 39 L. Ed. 553;
Weatherheard v. Coupe, 147 U. S. 322;
Jogger Mfg. Corp. v. Rocquemor (C. A. 7), 118 F. 2d 867, 870;
Walker on Patents, Deller Ed., Vol. 3, page 1695.

[2] *Vance v. Campbell*, Black (66 U. S.) 427, 430;
Hubbell v. United States, 179 U. S. 77.

one or one found in prior art, has consistently been held to negate infringement of that claim.[3] The Court's departure from this sound rule is intensified by its holding that even the omission of the **novel** element of the combination, in the present case the omission of the only element of the claimed combination that accounted for patentability—does not avoid infringement.[4]

The Court's majority was led into its inconsistent ruling by confusing the law applicable to a determination of the question of patentability, which was not at issue before the Court of Appeals, with the law applicable in determining issues of infringement.[5]

Whatever the cause, the Court's error of law goes to the very heart of the patent system. It gives a patentee a

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[3] Idem. See Authorities in Walker, Deller Ed., Vol. 3, page 1695.

[4] The Court of Appeals acknowledged that each of the patents of the prior art contains one or more elements which are substantially similar to Chernivsky's elements (Appendix A, pp. 20, 21), but that there was no single device which embodied, except for the coupling device, all of the elements of the Chernivsky device (Appendix A, pp. 19, 20). The Court then made the startling pronouncement:

> "This synthesis of ideas into a composite creation does not permit a competitor to separate this composite into the old elements that went into it and by slight modification of each element avoid each infringement *by omitting the novel element from its imitating device*" (Emphasis supplied).

[5] The Court said (Appendix A, pp. 19, 20):

> "We think the root of the District Court's error was in considering Chernivsky's claim 1, upon which his claims 2 and 3 rest, against the prior art piece by piece instead of considering the device totally, without properly applying the well-established principle that a combination of old elements in a manner that is unobvious to one skilled in the trade and which produces a new and useful result, may be patented"

and

> "Since a combination of old elements alone may be enough to constitute a patentable device, the addition of a new element to the combination should not, as the District Court seemed to conclude, result in a limitation of the claims to the new element."

monopoly on a combination which was neither claimed by nor granted to him.[6] It makes an infringer of a competitor who follows the teachings of the prior art and scrupulously avoids employing the novel feature of the combination which the patentee was compelled to include in order to secure his patent. It destroys the very purpose of patent claims, to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not. **General Electric Co. v. Wabash Corp.**, 304 U. S. 364.

II.

The Court of Appeals has expanded the doctrine of equivalents, contrary to prescribed limitations on that doctrine established by many decisions of this Court, and its own, such that the rights of this petitioner and of the public in unpatented articles has been and will be seriously impaired.

The grounds upon which the Court deviated from the prior rules are baseless and inappropriate.

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[6] The dissenting opinion comments on the Court's error. Judge Swygert said (App. A, pp. 23, 24):

> "In discussing what it considers to be "the root of the district court's error," the majority says that the district judge failed to apply 'the well-established principle that a combination of old elements in a manner that is unobvious to one skilled in the trade and which produces a new and useful result may be patented.' I do not disagree with this principle as enunciated. I think, however, that its application here is improper. Although a novel combination of old elements 'may' constitute invention, the Chernivsky patent was neither claimed nor granted on that basis. Thus; whether or not Chernivsky could have been granted a patent on that basis is irrelevant. The inventive-level characteristic of his structure resided solely in the frictional locking feature. The patent was granted only after the applicant had thus limited his claims. To construe the patent as this court now does is, in effect, to give Chernivsky a new patent—broader than the one which was granted to him."

The rule in question, applied by the District Court is:

> "Where a patent depends for its novelty over the prior art upon a single feature of construction, the claim cannot be expanded by any doctrine of equivalents to cover a device which lacks that single feature."

The rule is recognized and followed in the courts[7] and stems from the solid rule stated frequently by this Court that the omission of any essential element of a claim from an accused device averts a charge of infringement based on that claim.[8]

The Court below referred to the quoted rule (Appendix A, pp. 19, 20), noted a number of its own additional decisions which follow it, and then imposed a curious, unfounded limitation on the rule to distinguish the present case. The rule applies, the Court decided, if the prior art shows in a **single** preexisting device, the elements of the patented device except its novel element or feature, but does not apply where, as in the present case all of the elements are shown in the prior art, with the exception of the single novel one, but not in any one prior art device (emphasis supplied). The Court then made the new, untenable rule:

> "Since a combination of old elements alone may be enough to constitute a patentable device, the addition of a new element should not, as the District Court seems to conclude, result in a limitation of the claims to the new element"

and (Appendix A, pp. 20, 21):

> "The synthesis of ideas into a composite creation does not permit a competitor to * * * avoid infringe-

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[7] *Standard Mirror Co. v. H. W. Brown, Inc.*, 113 F. 2d 379 (7 Cir. 1940);
Schmitt v. Norcor Mfg. Co., 152 Fed. 519 (7 Cir. 1945);
Luberman v. Rowell, 170 F. 590, 592 (3 Cir. 1909).

[8] See cases cited in Footnote 1.

ment by omitting the novel element from its imitating device."

Why should the omission of the novel element from the combination avoid infringement in the case where the old elements of the combination are found in a single device of the prior art, but not where shown to be old, respectively, in several prior art devices? In each case the addition of the novel element was the factor that made the device patentable and accounted for the grant. As the dissenting judge so clearly pointed out, the patent here was neither claimed nor granted on a combination sans the locking feature.

The rule applied by the District Court is basic and sound in principle. It should not be encumbered with groundless exceptions and limitations through a misconstruction of the doctrine of equivalents.

To prevent the doctrine to be used to expand claims for a combination of old and new elements to cover a combination that omits the novel elements is, contrary to established rule, to deny competitors' rights in old and exhausted combination.

In the case of **The Ekco Products Company, Inc., v. Chicago Metallic Mfg. Co.**, decided June 17, 1965 by the Court of Appeals and as yet unreported (decision printed in Appendix C hereof) the Court referred to its decision in the present case and reaffirmed its erroneous ruling, saying (pp. 30, 31):

> "Plaintiff urges that our holding in **Welsh v. Chernivsky**, 342 F. 2d 586, is controlling. However, in **Welsh**, the patentee by amendment added a new element. We held that equivalents were available to the patentee where the prior art showed no single structure having all the claimed elements."

Clearly the new and inconsistent law in the Seventh Circuit established by its decision in the present case is greatly in need of correction.

For the foregoing reasons it is urged that this petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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APPENDIX A.

In the
United States Court of Appeals
For the Seventh Circuit.

No. 14509 September Term, 1964 September Session, 1964

Welsh Co.,
Plaintiff-Appellee,
v.
Victor A. Chernivsky, d/b/a Comfy Babe Company,
Defendants-Appellants.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

January 21, 1965

Before Duffy, Kiley and Swygert, **Circuit Judges.**

Kiley, **Circuit Judge.** Welsh Company sued for a declaration that defendant's patent, No. 2,842,040, was invalid and not infringed by a baby chair manufactured by Welsh. Chernivsky counterclaimed, charging infringement. The district court found the patent valid but not infringed, entered judgment accordingly, and this appeal followed. We think the court's judgment is right as to validity and erroneous as to infringement.

The patented article in suit is an infant seating device consisting of a base member and a back rest member formed of spring wire. These parts are so adapted that they may be disconnected for storing and shipping. The union of the two parts is by means of sleeves on the ends of the back rest member into which the extremities of

the base member are inserted. Comprising the third component of the structure is the seat, which consists of a fabric bag or envelope which slips over the back rest member. When so installed there is a fullness at the bottom of the fabric forming a pocket-like dip which receives the baby's buttocks. A cloth belt, loosely attached to each side of the back frame, is fastened to the fabric, at the front, to prevent the infant from falling out, and at the center of the belt extending downward to the bottom of the fabric is attached another cloth belt to separate the legs of the infant. The back frame is U-shaped, with the arc at the top having the function of pulling the fabric into a safe resting place at the center for the baby's head.

Chernivsky, while claiming that his and the Welsh chairs are equal for all practical purposes, admits that because the words of his claim 1 do not read upon the Welsh chair, a showing of infringement requires application of the doctrine of equivalents.

The decision below was that Chernivsky's patent monopoly was restricted to a narrow improvement over the prior art and that every feature of the accused device of Welsh "embodies elements all known in the prior art," but does not include the frictional locking feature "so vital" to the patent in suit. The court refused to apply the doctrine of equivalents in favor of Chernivsky and against the Welsh device, on the ground that Chernivsky had narrowed his claims to the locking feature in order to meet the examiner's objections and thus, under the doctrine of file wrapper estoppel, is precluded from expanding his claims by the doctrine of equivalents to cover the elements surrendered by amendment.

We shall examine the facts with respect to infringement before considering the effect of file wrapper estoppel on Chernivsky's claim to equivalence. Chernivsky argues

that Welsh duplicated, with "trivial changes," the "desirable features" of his patent to avoid the language of claim 1, but that there is infringement since both devices "do the same work in substantially the same way, and accomplish substantially the same result. . . ." **Sanitary Refrigerator Co. v. Winters**, 280 U. S. 30, 42 (1929). On oral argument before this court counsel for Welsh admitted that Welsh knew of the Chernivsky patent and attempted to design around it.

The rear cross-bar of the Welsh base is slightly lower than and exceeds slightly in width the base of Chernivsky's; the sides of both bases are slightly off parallel from back to front, the Welsh slightly outward and the Chernivsky slightly inward; the sides of the Welsh base are a little longer than those of the Chernivsky base; the bends at the ends of the sides on the Welsh base are shorter than those on the Chernivsky base and turn forward, while Chernivsky's flare outwardly without the forward turn; the Welsh sides turn upward at a slightly wider angle than Chernivsky's so that the sides of the Welsh back frame are in a more upright line than Chernivsky's, resulting in a less backwardly inclined whole.

The sides of the base frames, in both chairs, must be sprung inwardly in order to fit the extremities of the base into the sleeve extremities of the back frame. The base extremities of the Welsh device are from a front view substantially perpendicular to the plane of the base, while the extremities of the Chernivsky base angle inwardly. The tips of the extremities of the Chernivsky base then flare outwardly. The result of this outward turn at the tips of the Chernivsky base extremities is a tighter spring fit between the base and back frames. This is the "frictional locking" device referred to by the district court.

The bases of both devices are designed to give stability. The Chernivsky device accomplishes this through the rear

cross-bar and the comparatively extensive outward flaring of the front ends of the base to compensate for the comparatively narrower chair. The Welsh device compensates for lack of outward flaring front ends by having its cross-bar at the rear of the base wider and the sides extending outward toward the front so that they are several inches longer than the Chernivsky sides before turning inward, and at the point where they begin to turn the base of the Welsh device is about four inches wider than the Chernivsky base. The resting points of contact are slightly different, but in sum are about equal. The Chernivsky connection between the base and back frame is tighter and holds together—at least when not occupied—better than the Welsh device.

As we have stated, the back frames of both chairs are slightly outward from parallel as they reach toward their extremities, and the backward incline of the Chernivsky device is greater, occupied or not. The top of the back frame in the Chernivsky device is a broad curve resulting, when the chair is occupied, in a depression in the center of the fabric to accommodate the baby's head and maintain it in a safe center place. The top of the back of the Welsh device is not curved, but it is a cross piece which extends backwardly from each side to form a shallow V. When the chair is occupied this has the same result as the Chernivsky back frame.

We conclude that the Welsh device does accomplish the same result as the patent device by substantially the same means and that it is the equivalent thereof. **Independent Pneumatic Tool Co. v. Chicago Pneumatic Tool Co.**, 194 F. 2d 945 (7th Cir. 1952).

The question now is whether there is any room in the present case for application of the doctrine of equivalents, in view of the file wrapper estoppel doctrine. Because the district court's findings on the issue of file wrapper estop-

pel were based solely on documentary evidence, all of which is before us, those findings have not the same degree of finality which ordinarily attaches to findings of fact under Rule 52 (a) of the Federal Rules of Civil Procedure. **Taylor-Reed Corp. v. Mennen Food Products Co.**, 324 F. 2d 108, 111 (7th Cir. 1963). We hold that the district court's finding that Chernivsky narrowed his claim to the so-called "frictional locking device" is clearly erroneous and this finding was in part induced by an erroneous application of the law. It must therefore be set aside.

Chernivsky originally filed ten claims, the first two of which, as amended, are set out in the margin.[1] Because of rejections by the examiner on the basis of cited prior art, Chernivsky twice amended, and finally cancelled, these claims and substituted for them new claims 1, 2 and 3. After a conference with the examiner the patent issued on the claims. No claim of infringement is made with respect to claim 2, and claim 3 depends upon claim 1, which is set out in the margin.[2]

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[1] 1. In a resilient baby support, a margin frame spring wire base having parallel sides connected at the rear by an offset crosspiece forming a rear contact portion and having front ends with angular return bends extending outwardly and downwardly to form two front legs and the extremities of the ends extending upwardly and tilted backwardly, and a separate back rest spring wire margin frame having two parallel sides connected by a rounded portion at corresponding ends and the other ends having hollow extremities into which the said extremities of the ends of the base fit tightly but removably to hold the back rest over the base at an upward inclination rearwardly from the front of the base.

2. In a baby support in accordance with claim 1, the said extremities of the ends of the base flaring slightly outward out of line with the hollow extremities of the back rest providing greater stability so the extremities of the base must be sprung inwardly to engage them with the said hollow extremities thus increasing frictional engagement.

[2] 1. In a resilient baby support, a marginal frame, a spring wire base having substantially parallel sides connected at the rear by an offset cross piece forming a rear contact portion and having front ends with angular return bends extending outwardly and downwardly to form two front legs and the extremities of the ends

It can be seen that patent claim 1 is essentially an amendment of original claim 2, and that as granted claim 1 is broader, rather than narrower, than original claim 2. Original claim 2 described the extremities of the ends of the base as "flaring slightly outward out of line with the hollow extremities of the back rest," while patent claim 1 describes these extremities only as "inclined slightly out of line with the said hollow extremities." The meaning of the term "extremities of the ends" here becomes important. This term is used twice in patent claim 1, preceded the second time by the word "said." A normal reading of the claim, therefore, would attribute the same meaning to the term in both instances. The first use of the term occurs in the following phrase:

> . . . having front ends with angular return bends extending outwardly and downwardly to form two front legs and the extremities of the ends extending upwardly and tilted backwardly . . .

Reading the description against the Chernivsky chair makes it clear that the term in question refers to the entire segment of the base to which the back is attached. It must, then, have that same meaning in the second reference, and the phrase does not, as Welsh would have us read it, refer only to the outwardly bent tips of those segments. Patent claim 2[3] also contains the term "said ex-

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extending upwardly and tilted backwardly, a separate back rest spring wire marginal frame having two parallel sides connected by a rounded portion at corresponding ends and the other ends having hollow extremities, the said extremities of the ends of the base inclined slightly out of line with the said hollow extremities of the back rest so the extremities of the base must be sprung to engage in the hollow extremities and fitting tightly but removably therein to hold a back rest over the base at an upward inclination rearwardly from the front of the base.

[3] 2. A baby support in accordance with claim 1, in which the said extremities of the ends of the base flare slightly outward out of line with the hollow extremities of the back rest providing greater stability of the wire base when set up in supporting position.

tremities of the ends of the base," but there it is conjoined with "flare slightly outward" and does refer to the tips of the segments in question. The term "extremities of the ends" was used ambiguously, but we have resolved the ambiguity in what appears to us to be the most reasonable manner and one which is consistent with the presumption of the validity of the patent. If the term in claim 1 meant only the bent tips, then claim 2 would be practically redundant and superfluous.

In "remarks" filed with the substituted claims Chernivsky's attorney stated that "the applicant is not attempting to claim broadly any arm or other member which may be sprung into engagement with another. . . ." Both Welsh and the district court took this statement as indicating that Chernivsky was limiting his claim solely to the "frictional locking" device. The context of the patent and file wrapper shows, however, that the claim was not actually narrowed and that the statement in question was meant to indicate only that the springing action was claimed as part of the combination of parts which make up the Chernivsky patent.

The district court's findings and conclusion on the issue of file wrapper estoppel were closely related to, and dependent upon, its findings as to the prior art. The court stated that

> [I]n view of the narrow construction defendant necessarily placed on his claims in the Patent Office to distinguish them from the prior art, his claims do not cover the alleged infringing device which in each and every feature thereof embodies elements all known in the prior art.

In support of this conclusion the court cited the case of **Standard Mirror Co. v. H. W. Brown, Inc.**, 113 F. 2d 379 (7th Cir. 1940), where it was held that where a patent "depends for its novelty over the prior art upon a single

limited feature of construction, the claims cannot be expanded by any doctrine of equivalents to cover a device which lacks that single feature." The **Standard Mirror** case, however, and the cases which follow it, **Jacwil Mfrs. v. Batesville Casket Co.**, 311 F. 2d 38 (7th Cir. 1962), **cert. denied** 372 U. S. 942 (1963); **Fife Mfg. Co. v. Stanford Engineering Co.**, 299 F. 2d 223 (7th Cir. 1962); **Lewis v. Avco Mfg. Corp.**, 228 F. 2d 919 (7th Cir. 1956); have in common a fact which distinguishes them from the case at hand. In those cases the patented device contained only a single, limited improvement over a preexisting device in the prior art, and a broader construction of the claims than that allowed by the court would have rendered the patent invalid on the prior art. In the case before us, on the other hand, there was no single device in the prior art which embodied, except for the coupling device, all of the elements of the Chernivsky device.

We think the root of the district court's error was in considering Chernivsky's claim 1, upon which his claims 2 and 3 rest, against the prior art piece by piece instead of considering the device totally, without properly applying the well-established principle that a combination of old elements in a manner that is unobvious to one skilled in the trade and which produces a new and useful result may be patented. **Expanded Metal Co. v. Bradford**, 214 U. S. 366, 381 (1909); **Loom Co. v. Higgins**, 105 U. S. (15 Otto) 580, 591 (1881); **Kaakinen v. Peelers Co.**, 301 F. 2d 170 (9th Cir.), **cert. denied** 371 U. S. 823 (1962); **Anderson Co. v. Sears, Roebuck and Co.**, 265 F. 2d 755 (7th Cir. 1959); **Brown v. Brock**, 240 F. 2d 723 (4th Cir. 1957); **Weller Mfg. Co. v. Wen Products, Inc.**, 231 F. 2d 795 (7th Cir. 1956); **Blaw-Knox Co. v. I. D. Lain Co.**, 230 F. 2d 373 (7th Cir. 1956). Since a combination of old elements alone may be enough to constitute a patentable device, the addition of a new element to the combination should not, as the district court seemed to conclude, result in a limitation of the claims to the new element.

Considering the prior art discussed by the district court, we think the Pribil patent did not read on Chernivsky's, considered as a whole, since, among other things, in the Pribil device the infant lies down; the Blackledge patent's back rest does not accommodate small infants; Brown resembles Chernivsky's patent more closely, but has not the latter's detachable light base and back frames nor the resiliency; and Oullette has not the light detachable base and back frames nor the resiliency.

Each of the patents contains one or more elements which are substantially similar to Chernivsky's. But there was no combination of parts into any whole which is substantially similar to the patent in suit. Presumably Chernivsky, observing the prior art, drew ideas from the various devices and conceived the idea of a novel, useful and unobvious baby support which met a social need. This synthesis of ideas into a composite creation does not permit a competitor to separate this composite into the old elements that went into it and by slight modifications of each element avoid infringement by omitting the novel element from its imitating device.

We agree with the district court's conclusion that the commercial success achieved by Chernivsky's baby support with only modest promotion and the fact that still another competitor copied it in virtually every detail, while not sufficient of itself to establish the validity of the patent, **Jungersen v. Ostby & Barton Co.**, 335 U. S. 560, 567 (1949), does support the inference that the device was unobvious and filled a need. **Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.**, 321 U. S. 275, 279 (1944); **H. W. Gossard Co. v. J. C. Penney Co.**, 304 F. 2d 515 (7th Cir. 1962). Our difference with the district court is, of course, only over the scope of the patent. We think the inference is justified that such commercial success was not achieved solely because of the novel locking device, but because of the combination of all of the elements which comprised this new and useful whole.

For the reasons given, the judgment of the district court as to infringement is reversed and the cause is remanded for further proceedings consistent with the views expressed herein.

Reversed and remanded.

No. 14509.

Swygert, **Circuit Judge**, dissenting.

Reluctantly, I must disagree with Judge Kiley's opinion. I think that the district court properly applied the doctrine of file wrapper estoppel in denying infringement.

The district judge made extensive findings about the prior art and also about the history of the prosecution of the Chernivsky patent.[1] In addition to these findings, the

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[1] Findings pertinent to these matters include the following:

Infant seating devices of the type involved in this action are disclosed in Pribil patent No. 2,460,308 granted February 1, 1949, and in the Blackledge patent No. 704,774 granted July 15, 1902.

The Pribil patent discloses a baby support having a resilient frame structure which provides a flexible support. It is similar in construction and function to the baby seat of the Chernivsky patent in suit. It differs therefrom in that the backrest and base parts are not detachable, one from the other.

The Blackledge patent discloses a resilient baby support having a backrest which is detachably connected to a base member; it does not employ plug and tubular socket means for detachably connecting the frame members together.

The prior patent art contains examples of seating devices constituted by separable parts having their end portions connected together by plug and tubular socket means. The Examiner rejected original claims 1 through 10 on the grounds that no invention is involved in providing a backrest having hollow extremities in which fit the ends of a separable base in view of Brown or Barker, Fig. 5. Plaintiff acceded to this contention by cancelling those claims.

The concept of a sleeve connection between mating extremities of members of a supporting device, wherein the members have to be sprung together before effecting an interfitting relationship is old in the art, as shown in the Watrous patent.

The connecting means between the base and backrest frames of the Chernivsky patent are characterized by an outward bend or flaring of the extremities of the base frame so that they are not

file wrapper indicates that the patentee's first ten claims were rejected because they were anticipated by the Ouellette patent No. 2,324,421 granted July 13, 1943, the Barker patent No. 2,567,418 granted September 11, 1951, and the Brown patent No. 619,027 granted March 2, 1949 (Great Britian). Twice Chernivsky attempted to have these claims allowed after amendment and twice the examiner rejected the amended claims because of the prior art. Finally, Chernivsky withdrew the original claims and substituted

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in straight alignment with the tubular socket ends of the backrest frame when their extremities initially spring together. Consequently the said end portions do not slip freely and easily into interfitting relationship when merely sprung together. On the contrary the mating end portions, disposed at an angle one to the other, must be additionally stressed to bring them into straight alignment, before they can be fitted together.

The applicant described this special characteristic in distinguishing from the prior art saying:

"However, in the present invention, the applicant is covering an entirely different invention, namely, a provision of base and backrest parts having extremities which are secured together but in which the respective ends are neither parallel nor do they extend in the same direction, but the ends of one part must be sprung in order to engage with a hollow sleeve or with the ends of the other part to which they are connected. This construction is planned and deliberate since it results in an increased frictional cont ct between the parts and once the ends are sprung to engage with the other corresponding ends, it is difficult to disengage them without a reversal of the springing and sliding operation in connecting them."

In a later amendment defendant Chernivsky reiterated a distinguishing characteristic aforesaid and expressly disclaimed a construction wherein the parts may be simply sprung together and slid into interfitting relationship, as disclosed in the prior art Watrous patent, . . . and in the Barker patent, Fig. 5. The applicant Chernivsky expressly disclaimed such old and well-known sleeve connections stating: "The applicant is not attempting to claim broadly any arm or other member which may be sprung into engagement with another. . . ."

The plaintiff's device . . . is so constructed that when the extremities of the backrest and base members are brought into mutual registration the end portions are substantially in straight alignment so that they slip easily together, and without req iring an additional force to align the end portions. In this respect plaintiff's device accords with the disclosure of the prior art Watrous patent.

new claims that eventually became patent claims 1, 2, and 3.

In filing the new claims Chernivsky wrote the patent office in pertinent part:

> This application has been amended as a result of a conference courteously granted by the Assistant and Chief Examiners in charge of the application at which it was pointed out that the present invention differs entirely from the references of record in providing a wire base and a rear back portion in which the extremities of the ends of the base are sprung out of line with the ends of the back which are adapted to be engaged thereby, the corresponding ends of the back being provided with sleeves projecting beyond the ends into which the bent ends of the base may be sprung, thereby engaging and holding connection with the back more firmly, providing greater frictional engagement and fitting tightly together but allowing them to be slipped into and out of engagement with each other when desired.

Thus, Chernivsky narrowed his claims to a frictional locking feature. That this feature was the inventive distinction of his structure is also indicated by the claims themselves. All three are identical except for a different description in the wording of the frictional locking feature.

During the course of his decision, the district judge said:

> The file wrapper history plainly reveals that defendant gave a limited construction to his claims in order to obtain his patent.
>
> An examination of the file wrapper leaves no doubt that this patent was allowed only after defendant gave a very narrow scope to its claims. It is apparent from the successive rejections that without the frictional locking feature involving the flared stubs of the base member there was no invention.

> There is but one inference which can be reasonably drawn from the events preceding the issuance of the patent in suit and it is that defendant was but a slight improver in a crowded field where many others had sown. It is evident that broader interpretation of his claims would render them invalid on the prior art.
>
> The Court is convinced that the patent is not infringed by the plaintiff's device. This conclusion is based upon the doctrine that a patentee who is only a narrow improver, as is the case with the instant patent, has a monopoly restricted to that narrow improvement.
>
> Having narrowed the scope of his claims in order to obtain the patent, he [defendant] made his precise form a material element of his invention and cannot expand the scope of his claims by construction or resort to the doctrine of equivalents. . . .
>
> Plaintiff's baby support does not embody the frictional locking feature so vital to defendant's patent. It follows that "where a patent depends for its novelty over the prior art upon a single limited feature of construction, the claims cannot be expanded by any doctrine of equivalents to cover a device which lacks that single feature."
>
> (**Standard Mirror Co. v. H. W. Brown, Inc.**, 113 F. 2d 379 (7th Cir. 1940)).

In discussing what it considers to be "the root of the district court's error," the majority says that the district judge failed to apply "the well-established principle that a combination of old elements in a manner that is unobvious to one skilled in the trade and which produces a new and useful result may be patented." I do not disagree with this principle as enunciated. I think, however, that its application here is improper. Although a novel combination of old elements "may" constitute invention, the

Chernivsky patent was neither claimed nor granted on that basis. Thus, whether or not Chernivsky could have been granted a patent on that basis is irrelevant. The inventive-level characteristic of his structure resided solely in the frictional locking feature. The patent was granted only after the applicant had thus limited his claims. To construe the patent as this court now does is, in effect, to give Chernivsky a new patent—broader than the one which was granted to him.

I would adopt the reasoning of the district court and affirm the judgment.

A true Copy:

Teste:

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Clerk of the United States Court of Appeals for the Seventh Circuit.

APPENDIX B.

United States Court of Appeals
For the Seventh Circuit.

Chicago, Illinois 60610.

Tuesday, March 30, 1965.

Received Mar. 31, 1965, Bair, Freeman & Molinare.

Before
Hon. F. Ryan Duffy, Circuit Judge
Hon. Roger J. Kiley, Circuit Judge
Hon. Luther M. Swygert, Circuit Judge

Welsh Co.,
Plaintiff-Appellee,
v.
No. 14509
Victor A. Chernivsky, d/b/a Comfy Babe Company,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

It Is Ordered by the Court that the petition for a rehearing of this cause be, and the same is hereby, Denied.

(Judge Swygert voted to grant the petition.)

APPENDIX C.

In the
United States Court of Appeals
For the Seventh Circuit.

September Term, 1964—April Session, 1965.

No. 14859

The Ekco Products Company, Inc.,
Plaintiff-Appellee,
v.
Chicago Metallic Manufacturing Company,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

June 17, 1965.

Before Duffy, and Knoch, **Circuit Judges**, and Grant, **District Judge.**

Duffy, **Circuit Judge.** The instant suit involves the alleged infringement of United States Patent No. 2,724,-526 dated November 22, 1955, and entitled "Tin Plate Baking Pan."

Suit was originally brought by plaintiff for alleged infringements by defendant of four patents, namely, (a) No. 2,687,994, dated August 31, 1954, entitled "Method of Forming an Oxide Coating on Tin"; (b) the patent in the instant case; (c) No. 2,773,817, dated December 11, 1956, entitled "Composite Metal and Articles Thereof", and (d) No. 2,801,604, dated August 6, 1957, entitled "Processed Drawn Implement." For convenience and

brevity, these patents will be referred to as '994, '526, '817 and '604, respectively.

The District Court held that all four patents were invalid and that Patents '994, '526 and '817 were not infringed. An appeal was taken. We reversed the findings of invalidity as to the basic patent, '994, holding the patent was valid and infringed. **Ekco Products Co. v. Chicago Metallic Mfg. Co.**, 321 F. 2d 550.

We also reversed the judgment as to the three derivative patents, and remanded them to the District Court for further consideration in view of the comments made in our opinion. No judgment was rendered in this Court with reference to the merits of the three derivative patents.

After remand, the parties agreed to a consent judgment which was entered on March 16, 1964, adjudging that patents '817 and '604 were valid and infringed, but awarding no damages thereon.

The District Court believed there was no infringement of the patent in suit by defendant, but held that the remarks made in our previous opinion left it with no latitude and, therefore, found that Patent '526 which is involved in this appeal, was valid and had been infringed. We think the District Court was in error in this respect. If we had intended to order a judgment that '526 was infringed, we would have said so as we did with the '994 patent. We intended the District Court should make an independent judicial determination on this point.

The question now before us on this appeal is whether Patent '526 has been infringed by defendant's baking pans. That, in turn, depends on the legal scope of the claims in Patent '526. The structure of defendant's baking pans is not in issue.

The principal patent, '994, was directed to a method of coating a tin surface with an olive-green oxide. We

held that method was new and patentable. The instant patent does not relate to a method, but rather to a product.

The record discloses that Ekco tried for years to secure such a product patent. Despite four years of vigorous prosecution, including several interviews with the Examiner, the application stood finally rejected by the Patent Office. Until the final amendment, Ekco had claimed its product broadly as a baking pan having a steel base, an overlying layer of iron-tin alloy, a further layer of metallic tin, and a surface layer of olive-green tin oxide. There had been no claim that called for any specific thinkness of iron-tin alloy. After the final rejection, Ekco cancelled its previous claims and substituted two claims which were eventually granted in the patent. Therein, the patent monopoly was limited to pans in which the thickness of the iron-tin alloy was "approximately 10 to 15 micro-inches."

It is clear that the patent in suit issued only after Ekco had substituted narrower claims which included an explicit narrow range for the thickness of the alloy. It is, of course, fundamental, that Ekco may not recapture by resort to the doctrine of equivalents or otherwise, any part of what it surrendered by its amendment to its claims.

We recognize that in a situation such as we have before us, a file wrapper estoppel arises only through amendment and cancellation of claims to overcome rejection. We have held that the Court will look no further than to learn whether the patentee was forced to introduce such element to avoid rejection. **Taylor-Reed Corp. v. Mennen Food Products, Inc.**, 7 Cir., 324 F. 2d 108, 111.

The rule that governs the question before us is stated in **I. T. S. Rubber Co. v. Essex Rubber Co.**, 272 U. S. 429, at page 443: "It is well settled that where an applicant

for a patent to cover a new combination is compelled by the rejection of his application by the Patent Office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent."

Furthermore, a patentee that has narrowed his claim after rejection to secure allowance, is held strictly to the letter of the limited claims granted to him; by his amendment he recognizes the difference between the old claims and the new, and proclaims "his abandonment of all that is embraced in that difference." **Union Carbide & Carbon Corp. v. Graver Tank & Mfg. Co.**, 7 Cir., 196 F. 2d 103, 107.

We think that the plaintiff's claims cannot be interpreted to cover baking pans with thicker alloy layers than that recited in its claims, because the proceedings before the Patent Office demonstrate the only difference between baking pans oxide-coated by the anodic method of the '994 patent and those oxide-coated by the prior art "burning-in" method, was a thicker alloy layer in the burned-in pans. In truth, nothing in the '526 claims distinguishes the patented invention from the burned-in pans of the prior art except the recitation requiring the alloy layer to have a thickness of "approximately 10 or 15 micro-inches."

Plaintiff urges that our holding in **Welsh Co. v. Cherniv-sky**, 342 F. 2d 586, is controlling. However, in **Welsh**, the patentee by amendment added a new element. We held that equivalents were available to the patentee where the prior art showed no single structure having all the claimed elements. By contrast, here, the prior art burned-in pan was a structure wherein all of the elements of the combination were present—the steel base, the alloy layer, the tin layer and the oxide layer. It cannot be disputed that

the alloy layer was already included as an element in rejected application claims 28 and 29.

When claims 28 and 29 were replaced with claims 31 and 32 which became claims 1 and 2 of the patent, the thickness of the alloy layer was expressly delimited.

Holding as we do that defendant did not infringe Patent in suit, No. 2,724,526, the judgment of the District Court to the contrary must be and is

Reversed.

A true Copy:

Teste:

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Clerk of the United States Court of Appeals for the Seventh Circuit.